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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SHOSHO, CALLIE E

ART UNIT

PAPER NUMBER

1714

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/982,496	Applicant(s) SPRYCHA ET AL.	
	Examiner Callie E. Shosho	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The rejection is adequately set forth in paragraph 3 of the office action mailed 4/11/05 and is incorporated here by reference.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-2, 4-8, 15-16, 18-22, and 29-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Zhu (U.S. 6,251,175) taken in view of the evidence in either EP 1219462 or Wexler (U.S. 6,454,896).

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The rejection is adequately set forth in paragraph 5 of the office action mailed 4/11/05 and is incorporated here by reference.

With respect to claim 30, it is noted that the use of water in Zhu is not required, i.e. water “can be” used.

5. Claims 1, 3-10, 12-15, 17-24, and 26-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Trauernicht et al. (U.S. 6,247,801) taken in view of the evidence in either EP 1219462 or Wexler (U.S. 6,454,896).

The rejection is adequately set forth in paragraph 6 of the office action mailed 4/11/05 and is incorporated here by reference.

6. Claims 1-3, 5, 7-10, 15-17, 19, 21-24, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Mead et al. (U.S. 5,596,027) taken in view of the evidence in either EP 1219462 or Wexler (U.S. 6,454,896).

The rejection is adequately set forth in paragraph 7 of the office action mailed 4/11/05 and is incorporated here by reference.

7. Claims 1, 11, 15, 23, 25, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al. (U.S. 5,922,118) taken in view of the evidence in either EP 1219462 or Wexler (U.S. 6,454,896).

The rejection is adequately set forth in paragraph 8 of the office action mailed 4/11/05 and is incorporated here by reference.

8. Claims 1, 3, 5-7, 9-10, 12, 14-15, 17, 19-21, 23-24, and 26-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Tatum et al. (U.S. 6,379,441) taken in view of the evidence in either EP 1219462 or Wexler (U.S. 6,454,896).

The rejection is adequately set forth in paragraph 9 of the office action mailed 4/11/05 and is incorporated here by reference.

9. Claims 1-8, 15-22, and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 621319.

The rejection is adequately set forth in paragraph 10 of the office action mailed 4/11/05 and is incorporated here by reference.

Response to Arguments regarding 35 USC 112, 1st paragraph rejection

10. Applicants' arguments regarding the 35 USC 112, 1st paragraph rejection of record have been fully considered but they are not persuasive.

Previously, the examiner argued that the use of the phrase "non-fluorescent" signifies a "negative" or "exclusionary" limitation for which applicants had no support in the original disclosure and that the use of such negative limitation which does not appear in the specification as filed introduced new concepts and violated the description requirement of 35 USC 112, first

paragraph, *Ex parte Grasselli, Suresh, and Miller*, 231 USPQ 393, 394 (Bd. Pat. App. & Inter. 1983).

In response, applicants cite *In re Wertheim*, 191 USPQ 90, 97 (CCPA 1976) and argue that applicants did have possession as of the filing date of the claimed “non-fluorescent” pigment. Applicants note that the examiner conceded that present claims 3 and 17 do disclose only non-fluorescent pigments and that only non-fluorescent pigments are disclosed in the present specification. Applicants also note that it is not understood why the examiner is looking for a description of the excluded, unclaimed fluorescent pigment and ignores the written description of the claimed, non-fluorescent pigment.

It is noted that there is no explicit disclosure of the phrase “non-fluorescent” pigment in the specification as originally filed. While literal support in the specification is not necessarily required, nevertheless, there is nothing on the record at the time of filing of the original specification to support applicants’ amendment to exclude certain materials, i.e. fluorescent pigments, from the scope of the present claims. The phrase “non-fluorescent” pigment is a negative limitation and clearly excludes the use of fluorescent pigment. By inserting such phrase into the claims, given that there is no disclosure of such phrase in the specification, the examiner must look for support for such negative or exclusionary phrase in the specification. In order to determine if there is support for a phrase excluding fluorescent pigments, it must be determined if there is support to exclude such pigments.

Further, it is noted that the examiner is not ignoring the written description of the claimed non-fluorescent pigments. However, while the specification as originally filed discloses the use of pigments which are non-fluorescent, there is no disclosure of the phrase “non-fluorescent”

pigment in the specification. Thus, the insertion of such phrase into the claims introduces new concepts given that the expression exclusion of certain elements implies the permissible inclusion of all other elements not so expressly excluded. Thus, in the present claims, the express exclusion of fluorescent pigments (by the use of the phrase “non-fluorescent”) implies the inclusion of all non-fluorescent pigments for which there is no support in the specification. While there is support in the specification to recite the specifically recited pigments set forth in the specification (as done in newly added claim 30 which is not rejected under 35 USC 112, 1st paragraph), there is no support for the inclusion of all non-fluorescent pigments.

Applicants argue that prior to inserting “non-fluorescent” into the claims, the claims merely recited “pigment” which would include all fluorescent as well as non-fluorescent pigments. However, as stated above, this would not provide support to broadly recite “non-fluorescent” pigment. Further, it is has not been established that at the time of filing of the original specification that applicants had possession of the concept of excluding fluorescent pigment. By applicants’ own admission, the original disclosure of “pigment” would include fluorescent and non-fluorescent pigment. Thus, the concept of the exclusion of fluorescent pigment was not in possession of applicants at the time of filing of the original specification.

As evidence to support their position, applicants point to *Ex parte Mahabadi et al.*, 2003 WL 23012146 (BPAI 2003).

However, it is the examiner’s position that the situation in *Mahabadi* is different than that of the present application. In *Mahabadi*, the examiner argued that there was no support to recite “free of solvent” or “contains no solvent” given examiner’s position that water, which is a solvent, was in fact present. Further, in *Mahabadi*, not only was there no disclosure of solvent in

the specification, the specification also stated that one of the problems to overcome was excessive quantities of organic solvent and that solution coating techniques were undesirable. There are no such disclosures regarding fluorescent pigment in the specification of the instant application.

In contrast, in the present situation, applicants have amended the claims to recite “non-fluorescent” pigment which expressly excludes fluorescent pigments and thus implies the inclusion of all non-fluorescent pigments for which there is no support in the specification as originally filed.

Response to Arguments regarding 35 USC 112, 1st paragraph rejection

11. Applicants’ arguments regarding the 35 USC 102 rejections of record have been fully considered but they are not persuasive.

Specifically, applicants argue that none of the cited references, namely, Zhu, Trauernicht et al., Mead et al., Johnson et al., Tatum et al., or EP 621319, are proper 102 references against the present claims given that it is necessary to pick and choose various portions of each reference in order to arrive at the claimed invention. Applicants argue that none of the references provides specific example having all applicants’ claim limitations.

However, firstly, it is noted that “applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others.” *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Further, it is noted that EP 621319 does disclose example on page 6 which does recite all the claim limitations of claim 1, namely, pigment, organic solvent, resin, and base. Additionally, with respect to the

remaining references, it is the examiner's position that these are proper 102 references against the present claims given that each reference explicitly disclose all the ingredients presently claimed. In most cases, no picking and choosing is required and even if picking and choosing is required, the choice is amongst a small number of alternatives.

Specifically, the present claims require non-aqueous lamination ink comprising resin, non-fluorescent pigment, organic solvent and water-soluble compound selected from the group consisting of base, amino alcohol, and aminoacid.

With respect to Zhu, it is noted that Zhu discloses ink comprising organic solvent (col.3, lines 9-10), pigment (col.3, line 30), binder resin (col.4, line 10), and base (col.2, line 22). While one must pick the use of pigment as colorant, the choice is only from amongst pigment or dye. Similarly, with respect to the base, the choice is from small group of compounds.

With respect to Trauernicht et al., it is noted that Trauernicht et al. disclose ink comprising organic solvent (col.2, lines 29-30), pigment (col.3, lines 59-60), resin (col.4, lines 47-50), and base (col.5, lines 3-5). There does not appear to be any picking or choosing required with the exception of the colorant which Trauernicht et al. disclose is either pigment or dye. However, the use of pigment is explicitly disclosed and the choice is only from amongst pigment or dye.

With respect to Mead et al., it is noted that Mead et al. disclose that the ink is either aqueous or non-aqueous and that the use of water is preferred. However, it is noted that "nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims", *In re Nehrenberg*,

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280 F.2d 161, 126 USPQ 383 (CCPA 1960). Mead et al. also disclose the use of pigment, resin, and base (col.17, line 12, col.10, line 21, and col.12, line 23).

With respect to Tatum et al., it is noted that Tatum et al. disclose non-aqueous ink (col.3, lines 5-6) comprising resin (col.3, lines 49-58), pigment (cvol.3, line 59), and base (col.4, lines 35). While the claimed base is one of several neutralizers disclosed, the choice of the base is not from amongst a vast number of compounds but rather a small number of compounds.

With respect to EP 621319, it is noted that EP 621319 discloses non-aqueous ink comprising polyamide, pigment such as phthalocyanine, solvent such as ethanol, and base such as sodium hydroxide (page 4, lines 20, 24-25, and 30-36 and examples) and thus, EP 621319 meets the requirements of the present claims.

In light of the above, it is the examiner's position that Zhu, Trauernicht et al., Mead et al., Johnson et al., Tatum et al., and EP 621319 are proper 102 references against the present claims.

In response to examiner's previous position that non-aqueous inks can contain small amounts of water, applicants state that the examiner must provide evidence to support such statement.

In response, it is noted that Zahrobsky et al. (U.S. 5,510,415) defines non-aqueous solvent system as one having not more than about 5% water (col.11, lines 9-11) while Roman et al. (U.S. 2004/0187732) discloses non-aqueous vehicle that substantially comprises non-aqueous solvent and contains no more than 10% water (paragraphs 30-31).

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
12/27/05